

REMARKS

These remarks are responsive to the Office Action, dated January 25, 2006. Currently, claims 1-26 are pending in the application with claims 1, 10, 19, 24 and 25 being independent.

In the January 25, 2006 Office Action, Examiner rejected claims 1-9, 19-23, and 25 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,493,110 to Roberts (hereinafter, "Roberts"). This rejection is respectfully traversed.

In the January 25, 2006 Office Action, the Examiner rejected claims 10-18 and 26 under 35 U.S.C. 103(a) as being unpatentable over Roberts in view of U.S. Patent No. 6,334,109 to Kanevsky et al. (hereinafter, "Kanevsky"). This rejection is respectfully traversed.

In the January 25, 2006 Office Action, the Examiner rejected claims 24 under 35 U.S.C. 103(a) as being unpatentable over Kanevsky in view of Roberts. This rejection is respectfully traversed.

35 U.S.C. 102(e)

In the January 25, 2006 Office Action, the Examiner stated that, *inter alia*, "Applicant's arguments, see (*sic.*), filed November 4, 2005, with respect to the rejection(s) of claim(s) 1-26 under USC 103 having been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Roberts and Kanevsky". (See, Office Action, page 6). However, the Examiner failed to address Applicants' traversal of the Examiner's rejection, in the July 7, 2005 Office Action, of claims 1-21 and 24-26 under 35 U.S.C. 102(e). Instead, in the January 25, 2006 Office Action, the Examiner issued a 35 U.S.C. 102(e) rejection of claims 1-9, 19-23, and 25, which has substantially the same scope, as the 35 U.S.C. 102(e) rejection in the July 7, 2005 Office Action. Under MPEP § 707.07(f), the Examiner is obligated to answer all material traversed:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

Since, the Examiner did not address Applicants' traversal of the 35 U.S.C. 102(e) rejection in the July 7, 2005 Office Action, the Applicants hereby restate and reassert the arguments, filed in response to the July 7, 2005 Office Action, in response to the 35 U.S.C. 102(e) rejection of claims 1-9, 19-23, and 25 over Roberts in this Office Action. Thus, the 35 U.S.C. 102(e) rejections over Roberts in the July 7, 2005 Office Action and in the January 25, 2006 Office Action are traversed.

In the January 25, 2006 Office Action, the Examiner recites a pre-AIPA version of 35 U.S.C. 102(e) as a basis for his rejection of claims as anticipated by Roberts. As the Applicants stated in response to the July 7, 2005 Office Action, the pre-AIPA version of 35 U.S.C. 102(e) is relevant only when the prior art reference that the Examiner is relying upon to reject Applicant's claims is based on a published international application filed before November 29, 2000 that designated the United States. MPEP §§ 706.02(a), 2136-2136.05. Otherwise, the revised version of 35 U.S.C. 102(e) applies. In this case, Roberts does not claim the benefit of an international application, thus, the revised version of the 35 U.S.C. 102(e) applies and Roberts is not a proper reference.

In addition to the fact that Roberts is not a proper 35 U.S.C. 102(e) reference, Roberts does not anticipate the claims of the present Application, for the reasons discussed below.

In the Office Action, dated January 25, 2006, the Examiner rejected claim 1 as being anticipated by Roberts. Claim 1 recites a method of printing a receipt which includes an image, comprising downloading transaction information; retrieving an image associated with the transaction information; converting the image into a pixels matrix representation; and printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation.

Roberts discloses a system and a method for bar code rendering and recognition. Specifically, Roberts describes formatting data into a readable bar code format. The bar code format includes transaction data relating to a coupon, such as redemption amount, expiration or term of offer, identity of coupon holder, etc. (Col. 7, lines 1-15). Roberts generates coupons with a coupon data management program that uses a computer to request coupon data from the centrally located repository, which stores the coupon data and transmits it for printing. (Col. 8, lines 43-48). Roberts' bar code is encoded with user specific information, such as user name and/or other unique identification criteria such as a social security number or online services address (Col. 11, lines 54-57). Also, Roberts' coupons are based on demographic data and historic buying profiles stored in the demographic data file. (Col. 12, lines 44-47).

However, Roberts fails to disclose downloading transaction information and retrieving an image associated with the transaction information, as recited in claim 1. Instead, Roberts requests certain coupons based on the unique user identification information, which is unrelated to the downloaded transaction information recited in claim 1. In fact, Roberts selects coupons from coupon packages 40. (Col. 11, lines 13-25). The coupon packages are generated based on user specific data, such as, coupons selected data, coupons deleted data, coupons printed data and user demographics (e.g., user's name, social security number, etc. (Col. 11, lines 54-57)). Roberts also performs a marketing analysis based on this information to generate coupon packages. (Col. 11, lines 13-25; Col. 12, lines 8-11 and lines 42-49). This information is not the same as the downloaded transaction information, recited in claim 1. The disclosure of Roberts is different from the recitation of claim 1, where a receipt's image is printed based on transaction information, rather than pre-stored user identification information. Additionally, Roberts allows users to access an online database in order to obtain coupon data related to an advertised product (Col. 17, lines 52-55). Hence, no transaction information is being downloaded, contrary to the recitation of claim 1.

To print coupons, using the system disclosed in Roberts, the system requests coupon data from one of the coupon packages and employs its document generating module to print coupons with bar codes. (Col. 7, lines 17-27). Thus, Roberts does not retrieve any images associated with the transaction information, contrary to the recitation of claim 1.

Roberts also does not disclose selectively printing pixels corresponding to the pixel matrix representation. Roberts discloses bar code image parameters and how the bar code is defined by its width, stretching factor, misalignment factor, print area width, and aliased to smooth out the edges. (Col. 20, lines 10-59). However, Roberts does not disclose that the scan lines are printed by selectively printing pixels corresponding to the pixel matrix representation.

For the foregoing reasons, Roberts which is not a proper 35 U.S.C. 102(e) reference, does not disclose every element of claim 1 and claim 1 is not anticipated by Roberts and should be allowed.

Claims 19 and 25 are not anticipated by Roberts for at least the reasons stated above with respect to claim 1. As such, the rejections of claims 19 and 25 are respectfully traversed. The Examiner is requested to reconsider and withdraw his rejection of claims 19 and 25.

Claims 2-9 and 20-23 depend on independent claims 1 and 19 respectively. As such, claims 2-9 and 20-23 are not anticipated by Roberts for at least the reasons stated above with respect to claim 1. Thus, these rejections are respectfully traversed. The Examiner is requested to reconsider and withdraw his rejections of claims 2-9 and 20-23.

35 U.S.C. 103(a)

In the January 26, 2005 Office Action, the Examiner rejected claim 10 under 35 U.S.C. 103(a) as being unpatentable over Roberts in view of Kanevsky. This rejection is respectfully traversed.

Claim 10 recites, *inter alia*, a method of printing a coupon which includes an image, comprising monitoring transaction information; retrieving an image associate with the transaction information; converting the image into a pixel matrix representation; and printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation.

According to the Examiner, Roberts discloses all of the elements of claim 10 except that it “does not teach monitoring transaction information, comparing the information to a database.” However, the Examiner asserts that “Kanevsky teaches monitoring user transaction and

comparing the transaction to an advertisement database and downloading advertisement information from the database responsive to the match and printing the downloaded advertisement on a receipt or coupon.” (See, Office Action, Page 4).

As stated above, Roberts discloses a system and a method for bar code rendering and recognition. (See, Roberts, Abstract). Roberts includes a document generating module that creates a desired document, such as a coupon, by applying predefined document formatting rules to the received document. (Roberts, Col. 7, lines 17-20). Roberts checks the resolution of printers on which the document will be printed and optimizes the scale of the bar code so that the bar code lines and pixels perfectly align to avoid blurry or grainy lines. (Roberts, Col. 7, lines 32-36). Roberts scales the document based on the resolution of the printer and then delivers the document to the attached printer for printing. (Roberts, Col. 19, line 1-12 and Col. 19, line 61 to Col. 20, line 31).

However, in addition to failing to disclose monitoring transaction information as admitted by the Examiner in the January 25, 2006 Office Action, Roberts does not disclose, teach or suggest, *inter alia*, retrieving an image associated with the monitored transaction information, converting the image into a pixel matrix representation; and printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation. Instead, Roberts discloses formatting rules to scale a particular document in accordance with specific printer requirements. (Roberts, Col. 7, lines 17-40). Further, Roberts’ scaling module detects resolution of a particular printer and scales the document appropriately by using “the greatest whole number multiple of the number of required pixels to insure that the pixel data is aligned with the available pixel columns and center[ing] the image [(i.e., the bar code)] in the total available pixels.” (Roberts, Col. 20, lines 21-25). However, Roberts does not disclose a pixel matrix representation into which the retrieved image is converted, as recited in claim 10. Finally, Roberts does not disclose printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation, as recited in claim 10. In contrast, Roberts scales the image so that the scaled bar code image pixel width aligns perfectly with the print area pixel width to effectively eliminate inaccurate renderings and the resulting inaccurate deciphering of the bar code information. (Roberts, Col. 20, lines 10-15). Roberts does not print

bar codes according to the pixel matrix representation. Instead, it simply stretches/scales the bar code images to fit within a designated print area. Hence, Roberts does not disclose, teach or suggest all elements of claim 10.

In the January 25, 2006 Office Action, the Examiner stated that Kanevsky teaches monitoring transaction information. However, Kanevsky fails to cure the deficiencies presented by Roberts. Kanevsky describes a distributed personalized advertisement system and method. Kanevsky's advertisement is personalized to a particular user for a current transaction and is presented to the user at the point of sale or transaction terminal. (Kanevsky, Abstract). When a customer makes a purchase using Kanevsky's system, that customer's identity, goods/services being purchased and their prices (current transaction data) are communicated to a local server which relays the current transaction data to an advertisement server via a network. (Kanevsky, Col. 5, lines 40-43). Kanevsky then produces an advertisement based on the current transaction data. (Col. 5, lines 44-56).

Kanevsky does not disclose, teach or suggest, *inter alia*, retrieving an image associated with the transaction information, converting the image into a pixel matrix representation, and printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation, as recited in claim 10. In contrast, Kanevsky prints an advertisement based on customer data, products purchased and product prices. Hence, neither Roberts nor Kanevsky disclose, teach or suggest all elements of claim 10 and claim 10 should be allowed.

Improper to Combine References

There is no motivation or suggestion to combine Roberts and Kanevsky to produce the claimed invention. Roberts discloses a system that detects printer resolution requirements and scales an image (i.e., bar code) to fit within an area having a specific number of pixels. In contrast, Kanevsky discloses a system for printing advertisements based on customer information and products purchased by the customers. The technology disclosed in Roberts belongs to a class of "facsimile and static presentation processing" with a subclass of "size, resolution, or scale control" (Class 358/1.2). Whereas, the technology disclosed in Kanevsky belongs to a class of "data processing: financial, business practice, management, or cost/price determination" with a

subclass of “distribution or redemption of coupon, or incentive or promotion program” (Class 705/14). Clearly, Roberts and Kanevsky belong to different technological arts. Hence, it is improper to combine Roberts and Kanevsky, as the Examiner attempted in the January 25, 2006 Office Action without some disclosed motivation other than the present application. See, MPEP 2143.01:

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.).

Even if one were to combine Roberts and Kanevsky, the present invention is not realized. The combination of Roberts and Kanevsky discloses a system for printing advertisements based on information about customers and products purchased, where the advertisements are scaled to fit within a particular area. However, the improper combination of Roberts and Kanevsky fails to disclose, teach or suggest, *inter alia*, retrieving an image associated with transaction information; converting the image into a pixel matrix representation; and printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation, as recited in claim 10.

Thus, even the improper combination of Roberts and Kanevsky does not render claim 10 obvious. As such, this rejection is respectfully traversed. The Examiner is requested to reconsider and withdraw his rejection of claim 10.

Claims 11-18 depend from independent claim 10. As such, claims 11-18 are patentable over the combination of Roberts and Kanevsky for at least the reasons stated above with respect to claim 10. Thus, the rejections of claims 11-18 are respectfully traversed. The Examiner is requested to reconsider and withdraw his rejections of claims 11-18.

Claim 26 depends from independent claim 25. As such, claim 26 is patentable over the Roberts for at least the reasons stated above with respect to claim 25 (See, discussion of

Applicants' traversal of 35 U.S.C. 102(e) rejection over Roberts presented above). Further, Kanevsky does not cure the deficiencies of Roberts as stated above with respect to claim 10. Hence, the rejection of claim 26 is respectfully traversed. The Examiner is requested to reconsider and withdraw his rejection of claim 26.

In the January 25, 2006 Office Action, the Examiner rejected claim 24 under 35 U.S.C. 103(a) as being unpatentable over Kanevsky in view of Roberts. Claim 24 is patentable over the combination of Kanevsky and Roberts for at least the reasons stated above with respect to claims 1 and 10. Thus, the rejection of claim 24 is respectfully traversed. The Examiner is requested to reconsider and withdraw his rejection of claim 24.

CONCUSION

No new matter has been added.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney to expedite further processing of the application to allowance.

Applicants believe that no additional fees are due with the filing of this Amendment. However, if any additional fees are required or if any funds are due, the USPTO is authorized to charge or credit Deposit Account Number: 50-0311, Customer Number: 35437, Reference Number: 27996-030.

Respectfully submitted,



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